

PATENT APPLN. NO. 10/552,737
RESPONSE TO RESTRICTION REQUIREMENT AND
ELECTION OF SPECIES REQUIREMENT

PATENT

REMARKS

Initially, it is noted that claim 1 has been amended to exclude the compound 4-fluorobenzyl trichlorosilane. Claims 10 and 29 have been amended to include the limitation that R1-R2 is selected from the group consisting of pentafluorophenylmethyl, 4-trifluoromethyltetrafluorophenylmethyl and pentafluorophenylethyl. And a new claim, claim 167, has been added to the application which recites the compounds of the examples.

Referring to the Office Action, the Action is a restriction requirement in which the applicants are required to elect one of the following groups of claims for prosecution in this application:

(I) Claims 1, 59, 108 and 134, identified by the Examiner as being directed to chemical compounds of the formula $R1-R2-Si(X1)_3$;

(II) Claims 10, 29, 68, 85, 113, 122, 139 and 148, identified by the Examiner as being directed to polymer compositions;

(III) Claims 41, 99, 127 and 153, identified by the Examiner as being directed to integrated circuits;

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(IV) Claims 57 and 160, identified by the Examiner as being directed to methods for making chemical compounds of the formula $R_1-R_2-Si(X_1)_3$ and

(V) Claim 164, identified by the Examiner as being directed to a thin film composition.

Applicants elect the subject matter of group (II), claims 10, 29, 68, 85, 113, 122, 139 and 148, for prosecution in this application. This election is made with traverse.

The Office takes the position in the Action that there is no common technical feature among the different groups. As support for this position, the Office argues that claim 1 is anticipated by US 6,392,077, which in Example 21 discloses the compound 4-fluorobenzyl trichlorosilane.

Claim 1 has been amended to exclude the compound 4-fluorobenzyl trichlorosilane from the scope thereof. Claim 1 as amended is novel and unity of invention exists among the various groups of claims identified in the Action.

However, in the event that the Office takes the position that unity of invention does not exist among the Group I to V claims (as amended), applicants request that at least Groups (I) and (II) be examined together.

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MPEP § 803 provides that there are two criteria for a proper requirement for restriction between patentably distinct inventions. One, the inventions must be independent or distinct as claimed. Two, "[t]here would be a serious burden on the examiner if restriction is not required".

In the present case the second criteria is not satisfied. There will not be a serious burden on the Examiner if restriction is not required among Groups (I) and (II). The polymers of Group (II) are made with the new monomers of Group (I). The substituent R1-R2 at the silicon atom in the polymer must, regardless, be subjected to search.

The Action also includes an election of species requirement. Specifically, if any one of Groups II, III or IV is elected (the Examiner was contacted by applicant's undersigned representative to confirm this part of the requirement), an election of the following species is required:

b) a single polyorganosiloxane polymer, i.e., a single polymer composition with all R groups defined.

Applicant elects the polymer of claim 10 where R1-R2 is pentafluorophenylmethyl and R3 is vinyl. This election is made without traverse. Claims 10 and 29 read on the elected species.

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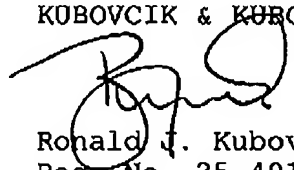
The foregoing is believed to be a complete and proper response to the Office Action dated December 22, 2009.

In the event that this paper is not considered to be timely filed, applicant hereby petitions for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,

KUBOVCIK & KUBOVCIK



Ronald J. Kubovcik
Reg. No. 25,401

Atty. Case No. LAIN-077
Crystal Gateway 3
Suite 1105
1215 South Clark Street
Arlington, VA 22202
Tel: (703) 412-9494
Fax: (703) 412-9345
RJK/ff